II.   REMARKS

Applicant offers the following remarks in response to the Final Office Action dated January 21, 2010.

A.   STATUS SUMMARY

Claims 1-32 were pending in the present application. Claims 2, 17, and 26 have been cancelled without prejudice. No claims have been added. Accordingly, claims 1, 3-16, 18-25, and 27-32 remain pending.

In this Amendment, Applicant has amended claims 1, 10, 16, and 25 and cancelled claims 2, 17, and 26 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claims 1, 10, 16, and 25 and 2, 17, and 26 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 1, 10, 16, and 25 were amended and claims 2, 17, and 26 were cancelled in this Amendment solely to facilitate expeditious prosecution of the present application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1, 10, 16, and 25 and 2, 17, and 26 as presented prior to this Amendment and additional claims in one or more continuing applications. Applicant believes that the amendments are fully supported by the application as originally filed and that no new subject matter has been added.

B.   CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 1-3, 5-11, 13-18, 20-23, 25-27, and 29-32 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2003/0023661 to

Clohessy et al. (hereinafter "Clohessy") in view of U.S. Patent No. 6,493,871 to McGuire et al. (hereinafter "McGuire"). Applicant respectfully traverses.

Claims 2, 17, and 26 have been cancelled without prejudice as indicated above. As such, the below discussion applies to claims 1, 3, 5-11, 13-16, 18, 20-23, 25, 27, and 29-32.

Applicant does not concede to the present rejections. Though Applicant has amended claims 1, 10, 16, and 25 for language preference, antecedent basis, form, and/or to expedite prosecution, Applicant provides the discussion below regarding the present rejections with respect to the language of certain portions of these claims, as entered prior to and after amendment, to further assist the Patent Office with a determination that the present rejections are in error for several reasons. Applicant has also combined the subject matter of claims 2, 17, and 26 with independent claims 1, 10, 16, and 25 to expedite prosecution of the present application. Applicant respectfully submits that restatement of the present rejections in a future Office Action would also be in error for at least the reasons discussed below. Applicant further believes the present amendments may assist the Patent Office with passing the present application to allowance and respectfully requests notice of the same at the earliest possible date.

In order for the Patent Office to establish *prima facie* obviousness, MPEP 2143.03 requires that "all claim limitations must be considered" and further that each and every word of the claims must be considered. ("All words in a claim must be considered in judging the patentability of that claim against the prior art." (MPEP 2143.03 quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). It is further noted that to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the

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prior art. (See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). This is fundamental to an analysis under the factual inquires required by *Graham v. John Deere*, 383 U.S. 1 (Supreme Court, 1966), as a part of identification of the scope and content of the prior art.

The Patent Office has failed to do so in the present rejection. At least one element is missing from the combination of references and the Patent Office has failed to provide any articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the prior art. (See *In re Kahn*, 441 F.3d 977, 988 (CAFC, 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required in order to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue. Accordingly, the Patent Office has failed to establish *prima facie* obviousness and the present rejection should be withdrawn.

The independent claims are claims 1, 10, 16, and 25. Applicant provides the discussion below with reference to the language of claim 1 for convenience. However, it is understood that the discussion below applies at least equally to each other independent claim with further consideration for the unique features of each other independent claim.

With reference to the rejection and language of claim 1, claim 1 recited prior to amendment, among other things, "substituting, upon determining that the list of the prerequisites that are not currently present on the client device would require more client device resources than the current resources of the client device, at least one other OSGi bundle that operates within the resource limitations of the client device for one of the OSGi bundles and one of the prerequisites of the list of the prerequisites that are not currently present on the client

device." The Patent Office admits that the Clohessy reference does not disclose this claimed

subject matter. (Final Office Action dated January 21, 2010, page 6). The Patent Office alleges

that this claimed subject matter is disclosed by the McGuire reference at column 4, lines 32-33

and column 4, lines 30-37. (*Id.* at page 7).

However, Applicant has reviewed the cited portion of the McGuire reference and notes

that the Patent Office has erred with respect to the actual disclosure of these cited portions.

Column 4, lines 30-37 of the McGuire reference discloses in its entirety that:

> The second server, in response to the request, prepares update files corresponding
> to the requested files and downloads them to the client. The downloaded files may
> or may not be exactly the requested files. Using the downloaded files, the setup
> program updates the existing files to create the set of installation files for the
> revised software product on the client computer. The revised software product is
> then installed on the client computer.

Applicant has identified several errors with the alleged disclosure of this cited portion of

the McGuire reference. First, the cited portion of the McGuire reference is speculative and is not

enabling. The actual disclosure appears to only disclose that downloaded files may or may not

be exactly the requested files. This speculative treatment provides no disclosure of any condition

upon which a downloaded file is not exactly the requested file. Further, Applicant finds no

disclosure of how one of ordinary skill in the art may select files other than the requested files to

download. As such, the disclosure of the McGuire reference is speculative and is not enabling

for how one may determine whether to download files that may or may not be exactly the

requested files.

Second, Applicant has claimed that its substituting is performed "upon <u>determining</u> that the list of the prerequisites that are not currently present on the client device <u>would require more client device resources</u> than the current resources of the client device . . . ." (Emphasis added). The cited disclosure of the McGuire reference does not appear to address or even consider performing any download of a file that is not exactly the requested file upon a condition of any type. Applicant respectfully submits that, for at least this reason, the Patent Office has erred with respect to the actual disclosure of the McGuire reference.

As such, the allegations of the Patent Office regarding the actual disclosure of the McGuire reference are in error and constitute errors of fact. These errors of fact regarding the scope and contents of the cited references results in additional error by failing to properly determine the differences between Applicant's claim language and the cited combination of references. Accordingly, the present rejection should be withdrawn for at least these reasons.

Third, Applicant has claimed substituting upon the determination discussed above "at least one other OSGi bundle that operates within the resource limitations of the client device for one of the OSGi bundles and one of the prerequisites of the list of the prerequisites that are not currently present on the client device." The actual disclosure of the McGuire reference is directed to downloading a file that may or may not be exactly the requested file.

In addition to this disclosure failing to enable a person of ordinary skill in the art, Applicant respectfully submits that it finds no disclosure of Applicant's claimed substituting at least one other OSGi bundle for one of the OSGi bundles and one of the prerequisites of the list of the prerequisites that are not currently present on the client device. Applicant additionally

finds no disclosure of Applicant's claimed substituting at least one OSGi bundle that operates

within the resource limitations of the client device for one of the OSGi bundles and one of the

prerequisites of the list of the prerequisites that are not currently present on the client device.

As such, the allegations of the Patent Office regarding the actual disclosure of the

McGuire reference are in error and constitute errors of fact. These errors of fact regarding the

scope and contents of the cited references results in additional error by failing to properly

determine the differences between Applicant's claim language and the cited combination of

references. Accordingly, the present rejection should be withdrawn for at least these additional

reasons.

Based upon this analysis, in addition to the errors discussed above, the Patent Office has

either unreasonably over-broadened Applicant's claim language or unreasonably over-broadened

the actual disclosure of the cited combination of references. For at least this additional reason,

the Patent Office has erred by failing to properly determine the differences between Applicant's

claim language and the cited combination of references. Accordingly, the allegations of the

Patent Office are in error and the present rejection should be withdrawn for at least this

additional reason.

Further, to expedite prosecution, Applicant has amended the phrase "current device

resources" of Applicant's independent claims, as suggested by Examiner Keehn. (Final Office

Action dated January 21, 2010, page 19). As such, the "current device resources" phrase now

recites the "current device OSGi package and service interface resources." (Emphasis as

amended). The Clohessy reference appears limited to runtime resources (e.g., RAM, threads,

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and sockets). (Clohessy, para. 0034). The McGuire reference appears limited to determining file deficiencies. (McGuire, Summary). Applicant respectfully submits that the errors discussed above in combination with these amendments provide ample support of patentability within the record of Applicant's claims relative to the references as cited.

Applicant has further amended its independent claims to recite, among other things, a variation of "<u>automatically recursively</u> resolving, upon determining that the list of the prerequisites that are not currently present on the client device would not require more client device <u>OSGi package and service interface</u> resources than the current <u>OSGi package and service interface</u> resources of the client device, the prerequisites by identifying a final set of OSGi bundles on the server that fulfills the prerequisites within the resource limitations of the client device . . . ." The recursive language was previously claimed within claims 2, 17, and 26 (cancelled herein without prejudice) and has been added to Applicant's independent claims 1, 10, 16, and 25 to expedite prosecution of the present application. As such, Applicant addresses the rejection of claims 2, 17, and 26 with respect to this claimed subject matter. Applicant respectfully submits that restatement of the present rejection with respect to this claimed subject matter in a future Office Action would be in error as discussed below.

The Patent Office alleges with respect to its rejection of claims 2, 17 and 26 that Figure 4 of the Clohessy reference discloses recursively performing its processing until prerequisites are completely resolved in steps "104-106-108-109-110-112-104-etc." (Final Office Action dated January 21, 2010, pages 7-8, 12, 14). However, Applicant has reviewed the cited disclosure and finds that the Patent Office has erred.

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Figure 4 is actually directed to determining maximum runtime resources (e.g., RAM, threads, and sockets) at step 102. These disclosed resources have been further distinguished by Applicant's amendments herein.

Further, the actual disclosure of the Clohessy reference indicates that "[i]f the maximum required runtime resources exceed the CARSRMAX, the identified one or more new application components <u>will be prohibited from loading</u> into the portable device at step 109." (Clohessy, para. 0043, emphasis added). As such, if the resources are exceeded, the Clohessy reference does not recursively resolve prerequisites. In contrast to Applicant's claimed subject matter, the Closhessy reference actually prohibits an application component from being loaded at step 109.

Additionally, "[a]t step 110, the <u>operator</u> of the portable device will make a decision regarding whether the identified one or more new application components should be loaded despite the insufficiency of the CARSRMAX." (Clohessy, para. 0044, emphasis added). As such, the Clohessy reference does not, in fact, recursively resolve prerequisites. In contrast, the Clohessy reference either prohibits application components from loading or requires an operator to make a decision whether to load the application despite the insufficiency of the CARSRMAX.

Further, "[i]f the operator decides to load the identified one or more new application components, at step 112, one or more application components previously loaded into the portable device <u>are removed</u> from the portable device at the direction of the operator and the maximum required runtime resources reserved for use by the one or more previously loaded application components are released." (Clohessy, para. 0044). As such, the Clohessy reference actually discloses removing application components and releasing resources used by the removed

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application components. Accordingly, the Clohessy reference actually discloses repeatedly removing applications until the CARSRMAX of the application component to be loaded exist within the client device.

Based upon this analysis, the Clohessy reference does not disclose Applicant's claimed recursively resolving prerequisites by identifying a final set of OSGi bundles on the server that fulfills the prerequisites within the resource limitations of the client device. In contrast, the Clohessy reference prohibits application components from being loaded, requires operator intervention to make a decision regarding whether to load the application despite insufficient CARSRMAX, and if the operator decides to load the new application, one or more application components previously loaded are removed from the portable device to release run time resources. Applicant respectfully submits that releasing run time resources is both distinct and distinguishable from recursively resolving prerequisites by identifying a final set of OSGi bundles on the server that fulfills the prerequisites within the resource limitations of the client device . . . ."

As such, the allegations of the Patent Office regarding the actual disclosure of the Clohessy reference are in error and constitute errors of fact. These errors of fact regarding the scope and contents of the cited references results in additional error by failing to properly determine the differences between Applicant's claim language and the cited combination of references. Accordingly, Applicant respectfully submits that restatement of the present rejection of this claimed subject matter in a future Office Action would be in error.

Applicant's amendment to recite <u>automatically recursively</u> <u>resolving</u> to prerequisites further distinguishes the disclosure of the Clohessy reference where, at step 110, the <u>operator</u> of the portable device intervenes to make a decision regarding whether the identified one or more new application components should be loaded despite the insufficiency of the CARSRMAX. As such, for at least this additional reason, restatement of the present rejection in a future Office Action would be in error.

Based upon this analysis, the factual disclosure of the cited portions of the Clohessy and McGuire references is different from that alleged by the Patent Office and distinct from Applicant's claimed subject matter. The Patent Office has not alleged that either the McGuire reference cures this deficiency of the Clohessy reference or that the Clohessy reference cures the deficiency of the McGuire reference. Applicant believes that the references as cited do not cure these deficiencies. As such, the claimed subject matter discussed above is not taught or suggested by the combination of references as cited. Further, the Patent Office has not provided any articulated reasoning as to why a person of ordinary skill in the art would find the claims as a whole obvious in the absence of the claim features not present in the cited combination of references. Accordingly, the Patent Office's allegations of the factual disclosure of the Clohessy reference in combination with the McGuire reference are in error and the rejection of claims 1, 10, 16, and 25 should be withdrawn for at least these additional reasons. The Patent Office has further erred by failing to properly determine the differences between Applicant's claim language and the cited combination of references. Additionally, the Patent Office's legal

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conclusion of obviousness is also in error as at least being based upon erroneous factual allegations.

As such, the Final Office Action dated January 21, 2010, fails to identify multiple elements of independent claims 1, 10, 16, and 25 within the combination of the cited references. Accordingly, the Patent Office has failed to establish a *prima facie* case of obviousness and the rejection of claims 1, 10, 16, and 25 should be withdrawn for at least this reason. Applicant reserves the right to provide additional arguments against the combination of the Clohessy reference with the McGuire reference in the future if needed.

Claims 3 and 5-9 depend from claim 1. Claims 11 and 13-15 depend from claim 10. Claims 18 and 20-23 depend from claim 16. Claims 27 and 29-32 depend from claim 25. Accordingly, the rejection of claims 3, 5-9, 11, 13-15, 18, 20-23, 27, and 29-32 should be withdrawn for at least the same reasons as the independent claims from which they depend. Applicant respectfully submits that claims 1, 3, 5-11, 13-16, 18, 20-23, 25, 27, and 29-32 are in condition for allowance and notice of the same is requested at the earliest possible date.

Claims 4, 12, 19, and 28 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Clohessy in view of U.S. Patent Application Publication No. 2003/0131226 to Spencer et al. (hereinafter "Spencer"). Claim 24 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Clohessy, in view of McGuire, and further in view of U.S. Patent Application Publication No. 2005/0004974 to Sharma et al. (hereinafter "Sharma"). Applicant respectfully traverses.

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The standards for establishing a *prima facie* case of obviousness have been set forth above. The Patent Office has not established a *prima facie* obviousness and the present rejection should be withdrawn.

Claim 4 depends from claim 1. Claim 12 depends from claim 10. Claims 19 and 24 depend, either directly or indirectly, from claim 16. Claim 28 depends from claim 25. Accordingly, the rejection of claims 4, 12, 19, 24, and 28 should be withdrawn for at least the same reasons as the independent claims from which they depend. Additionally, the Patent Office has not alleged that the Spencer reference cures the deficiencies discussed above with respect to the combination of the Clohessy and McGuire references and the Patent Office has not alleged that the Sharma reference cures the deficiencies discussed above with respect to the combination of the Clohessy and McGuire references. Further, the Patent Office has not provided any articulated reasoning as to why a person of ordinary skill in the art would find the claims as a whole obvious in the absence of the claim features not present in the cited combination of references. Accordingly, for at least these additional reasons the rejection of claims 4, 12, 19, 24, and 28 should be withdrawn. Applicant reserves the right to provide additional arguments against the combination of the Clohessy reference with the McGuire, Spencer, and Sharma references in the future if needed. Applicant respectfully submits that claims 4, 12, 19, 24, and 28 are in condition for allowance and notice of the same is requested at the earliest possible date.

The undersigned additionally notes that many distinctions exist between the cited references and the claims. However, in view of the deficiencies discussed above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the

Final Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort.

Applicant additionally notes that the Patent Office has alleged certain disclosure with respect to specific references to form the present rejections. Applicant addressed certain of these specific allegations above. However, it is understood that Applicant's arguments are directed to the combination of references as cited.

Applicant respectfully submits that claims 1, 3-16, 18-25, and 27-32 are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

III.   CONCLUSION

In light of the above Amendments and Remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Although it is believed that the appropriate fees are submitted with this transmittal, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 09-0461.

Respectfully submitted,

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Date: April 5, 2010   By: /Christopher B. Lee/

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